

Notice of Allowability

Application No.

09/722,760

Examiner

Janis L. Dote

Applicant(s)

MICHEL ET AL.

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1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 11 April 2007.
2. ☒ The allowed claim(s) is/are 6-8, 22, 23 and 25.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date 4/11/07
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

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1. The examiner acknowledges the amendments to claims 6, 7, 22, 23, and 25, and the cancellation of claims 1, 4, 9, 10, 17, and 24, filed on Apr. 11, 2007. Claims 6-8, 22, 23, and 25 are pending.

REASONS FOR ALLOWANCE

2. The following is an examiner's statement of reasons for allowance:

The rejections of claims 1, 6-8, and 23-25 under 35 U.S.C. 112, second paragraph, set forth in the office action mailed on Dec. 12, 2006, paragraph 8, have been withdrawn in response to the cancellation of claims 1 and 24 and the amendment to claims 6, 7, 23, and 25 filed on Apr. 11, 2007.

The objections to claims 1, 23, and 25 set forth in the office action mailed on Dec. 12, 2006, paragraph 9, have been withdrawn in response to the cancellation of claim 1 and the amendments to claims 23 and 25 filed on Apr. 11, 2007.

The rejection of claims 1, 6-8, and 22-25 under 35 U.S.C. 103(a) over Japanese Patent 8-6295 (JP'295) combined with US 3,925,278 (Murai), US 4,992,262 (Nakagaki), and US 5,385,776 (Maxfield), set forth in the office action mailed on Dec. 12, 2006, paragraph 11, has been withdrawn in response to the cancellation of claim 1 and the amendment to claims 7 and 25

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filed on Apr. 11, 2007. Amended independent claims 7 and 25 recite "[a] method of imparting, controlling or improving the charge of an electrophotographic toner or developer, or an electret material, consisting of adding only a structured silicate salt . . . to a binder of an electrophotographic toner or developer or of an electret material . . ." (emphasis added). As discussed in the office action mailed on Dec. 12, 2006, paragraph 11, JP'295 discloses a method of adding a charge controlling agent composition that comprises the charge controlling quaternary ammonium salt compound (1) of Table 1 of JP'295 and organic bentonite, as an "extender," to a binder resin of a toner. See the DERWENT machine-assisted translation, Table 1 at page 21, line 1; paragraph 0052, charge controlling agent composition 4; and paragraph 0054. The combined teachings of the secondary references of Nakagaki, Murai, and Maxfield teach that "organic bentonite" can include the commercially available BENTONE-34, which is identified as a montmorillonite whose interlayer cations were ion-exchanged for distearyldimethyl ammonium cation. Said organic bentonite is within the structured silicate salt compositional limitations recited in instant claims 7 and 25. However, the closed language in instant claims 7 and 25, "consisting of only adding a structured silicate salt," excludes the JP'295 method of

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adding its charge controlling agent composition, which comprises not only organic bentonite, but also the charge controlling quaternary ammonium salt compound (1). Moreover, the instant invention would not have been obvious because the "extra" component is disclosed to be essential to JP'295. Removing the essential component would destroy the reference.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system,

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see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLD

Jun. 21, 2007

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